

("the Vanderplas abstract"). However, the following statement by the Patent Office Board of Appeals is noteworthy:

Our reviewing courts have often advised the Patent and Trademark Office that it can satisfy the burden of establishing a *prima facie* case of obviousness only by showing some objective teaching in either the prior art, or knowledge generally available to one of ordinary skill in the art, that "would lead" that individual "to combine the relevant teachings of the references."Accordingly, an examiner cannot establish obviousness by locating references which describe various aspects of a patent applicant's invention without also providing evidence of the motivating force that would *impel* one skilled in the art to do what the patent applicant has done. *Ex parte Levengood*, 28 U.S.P.Q.2d 1300, 1302 (Pat. Off. Bd. App. 1993) (citations omitted; emphasis added).

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As the Examiner fails to provide "evidence of [a] motivating force that would impel one skilled in the art" to substitute the chiral agents of the Jursic reference to result in the claimed invention, a *prima facie* case of obviousness has not been established.

The Jursic reference discloses a method of resolving *four stereoisomers* of 2-phenyl-2-(2-piperidyl) acetamide using aromatic amine compounds. The amine compounds resolve the components of the mixture through their ability to form π - π aromatic stacking and hydrogen bonding. The Jursic reference teaches that these characteristics are necessary to resolve the mixture into its four components. As none of the resolving agents in the remaining cited references possess these characteristics, the skilled artisan would not have been motivated to substitute them in the methods of the Jursic reference without some indication in the prior art that the modification was desirable. *In re Laslowski*, 10 U.S.P.Q. 2d 1276, 1278 (Fed. Cir. 1987)("the mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art *suggested the desirability of the modification*")(emphasis added).

In fact, the skilled artisan would not have been motivated to combine the cited references as this combination would frustrate the purpose of the Jursic reference, which is to resolve a mixture of 4 stereoisomers. The resolving agents taught by Berrang, Ohashi, and Vanderplas show only the capability to resolve the mixture into two components, which would not serve the function of the resolving agents taught by Jursic. Accordingly, motivation to combine the references is lacking. *See, In re Fritch*, 23 U.S.P.Q. 2d1780 (Fed. Cir. 1992)(if a proposal for modifying the prior art in an effort to attain the claimed invention causes the art to become inoperable or destroys its intended function, then the requisite motivation to make the modification would not have existed.)

To support the obviousness rejection, the Office Action makes an “obvious to try” argument by stating that the differences in chemical structure “between the chiral reagent of Jursic and Berrang, Ohashi, and Vanderplas would not have prevented the picking and choosing by artisan in the field since all of them are known to be conventionally operable with amines.” Not only does this “obvious to try” standard for an obviousness determination lack basis in the law, the skilled artisan would not be motivated to “pick or choose” the chiral reagents of the Berrang, Ohashi, and Vanderplas references, because as discussed above, the cited art does not indicate that these agents would resolve the mixture of Jursic into 4 components. Without some reasonable likelihood of success, evidence of motivation is lacking. *See, In re Dow Chem. Co. v. American Cyanamid*, 5 U.S.P.Q. 2d 1529, 1531 (Fed. Cir. 1988)(“both the suggestion and the expectation of success must be founded in the prior art . . .”)

Claim 12 stands rejected under 35 U.S.C. § 103 (a) as being allegedly unpatentable over Jursic *et al.* in view of Berrang *et al.*, Ohashi *et al.* or Vanderplas *et al.*, further in view of Patrick, (*Synthesis of Deuterium-Labelled Methylphenidate, p-Hydroxymethylphenidate, Ritalinic Acid and p-Hydroxyritalinic Acid*, School of Medicine, University of North Carolina.)

Claims 1-8, 10-11, and 13 stand rejected under 35 U.S.C. § 103 (a) as being unpatentable over Jursic in view of Berrang, Ohashi, or Vanderplas and Feng (CA 117:111440, *J. Med. Chem.*, 1992, 35(16) . This rejection assumes that the obviousness rejection discussed above is

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proper and relies on the Feng reference for its disclosure of fractional crystallization of amine compounds.

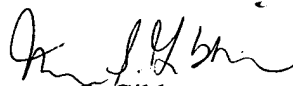
Claim 12 stands rejected under 35 U.S.C. § 103 (a) as being unpatentable over the Jursic reference in view of Berrang, Ohashi, Vanderplas, and Feng, further in view of Patrick *et al.* (*J. of Labelled Compounds and Radiopharmaceuticals*, 1981, 9, p. 485-490).

All of these rejections, however, assume that a proper rejection under 35 U.S.C. § 103 (a) has been established with respect to claim 1. As discussed above, claim 1 is not obvious over the Jursic reference in view of Berrang, Ohashi, Vanderplas. None of the additional cited art remedies the deficiencies of these references. Accordingly, the rejection should be withdrawn.

Claims 1-8 and 10-13 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of U.S. Pat. No. 5,936,091. Upon indication of allowable subject matter, Applicants will consider the necessity of filing a terminal disclaimer.

Applicants believe that the claims are now in condition for allowance. An early Office Action to that effect is, therefore, earnestly solicited.

Respectfully submitted,


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